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In re Application of	:	
DIEFENBACHER et al.	:	
Application No.: 10/598,639	:	DECISION
PCT No.: PCT/EP2005/051057	:	
Int. Filing Date: 09 March 2005	:	
Priority Date: 10 March 2004	:	
Attorney Docket No.: 5880	:	
For: METHOD AND SCANNING ARRANGEMENT	:	
FOR THE CONTACTLESS SCANNING OF THREE-	:	
DIMENSIONAL OBJECTS AND DEVICE FOR	:	
HOLDING THE OBJECTS	:	

This is a decision on applicants' petition under 37 CFR 1.47(a) filed 26 November 2007 in the United States Patent and Trademark Office (USPTO). The petition is **DISMISSED** without prejudice.

BACKGROUND

On 09 March 2005, applicants filed international application PCT/EP2005/051057, which designated the United States and claimed a priority date of 10 March 2004. A copy of the international application was communicated from the International Bureau to the USPTO on 22 September 2005. The thirty-month period for paying the basic national fee in the United States expired at midnight on 11 September 2006 (10 September 2006 being a Sunday).

On 07 September 2006, applicants filed a submission for entry into the national stage in the United States which was accompanied by, *inter alia*, the U.S. Basic National Fee.

On 26 April 2007, the United States Designated/Elected Office (DO/EO/US) mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating, *inter alia*, that an oath or declaration of the inventors in compliance with 37 CFR 1.497(a)-(b) and the surcharge under 37 CFR 1.492(h) were required. The NOTIFICATION set a two-month extendable period for response.

On 13 September 2007, applicants filed a response including a declaration of inventors, the surcharge under 37 CFR 1.492(h), and a petition/fee for a three month extension of time.

On 26 October 2007, the DO/EO/US mailed a NOTIFICATION OF DEFECTIVE RESPONSE (Form PCT/DO/EO/916) indicating, *inter alia*, that the declaration submitted 13 September 2007 was not in compliance with 37 CFR 1.497(a)-(b) because it did not indicate the inventor Dean Stoops.

On 26 November 2007, applicants filed the instant submission which includes, *inter alia*, a petition under 37 CFR 1.47(a).

DISCUSSION

Declaration of Inventors

37 CFR 1.41(a)(4) states:

The inventorship of an international application entering the national stage under 35 U.S.C. 371 is that inventorship set forth in the international application, which includes any change effected under PCT Rule 92bis. See § 1.497(d) and (f) for filing an oath or declaration naming an inventive entity different from the inventive entity named in the international application, or if a change to the inventive entity has been effected under PCT Rule 92bis subsequent to the execution of any declaration filed under PCT Rule 4.17(iv) (§ 1.48(f)(1) does not apply to an international application entering the national stage under 35 U.S.C. 371).

The declaration filed 13 September 2007 does not list the inventorship set forth in the international application. The declaration identifies one inventor while the international application identifies two inventors. A Form PCT/IB/306 (NOTIFICATION OF THE RECORDING OF A CHANGE) from the International Bureau indicating that an inventor has been deleted does not appear in the file. Accordingly, the inventorship in the national stage is the inventorship set forth in the international application and the declaration filed 13 September 2007 is not sufficient. (37 CFR 1.41(a)(4) is not affected by the preliminary amendment filed 26 October 2007.)

Petition Under 37 CFR 1.47(a)

A petition under 37 CFR 1.47(a) must be accompanied by: (1) the fee under 37 CFR 1.17(h); (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort; (3) a statement of the last known address of the missing inventor; and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor.

As to item (1), the petition fee of \$200 has been charged to Deposit Account 19-2110.

Item (2) has not been satisfied. To establish a refusal to sign, it is required that the inventor be presented with the application papers (specification, including claims, drawings, and oath or declaration). See MPEP 409.03(d). "It is reasonable to require that the inventor be presented with the application papers before a petition under 37 CFR 1.47 is granted since such a procedure ensures that the inventor is apprised of the application to which the oath or declaration

is directed. *In re Gray*, 115 USPQ 80 (Comm'r Pat. 1956)." Here, it is not clear whether Dean Stoops was presented with a copy of the application papers. Regarding the refusal of Dean Stoops, MPEP § 409.03(d) states in part:

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Here, a refusal has been alleged but no statement of facts has been provided.

Item (3) has been met.

Item (4) has not been met. The declaration submitted 13 September 2007 is not in compliance with 37 CFR 1.497(a)-(b) because it does not identify all of the inventors.

CONCLUSION

For the above reasons, applicants' petition under 37 CFR 1.47(a) is **DISMISSED**, without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. A proper response must specify whose signature is below non-signing inventor Fergus Francis Murray's name. **Failure to timely file the proper response will result in abandonment of this application.** Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)". No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

Please direct further correspondence with respect to this matter to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

/Daniel Stemmer/

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